

REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.111 are respectfully requested.

As correctly reflected in the Office Action Summary, claims 1-2 are pending in the application. Both claims 1 and 2 were indicated as subject to a Restriction and/or Election Requirement.

Applicants have amended claims 1 and 2 to recite only the elected group of TNF- α inhibitors: (a) metalloproteinase inhibitors excluding methylprenisolone. New claims 3-48 are dependent claims directed to either the method or pharmaceutical composition. Support for these claims can be found at least in the as-filed claims of the priority PCT Application, PCT No. PCT/SE99/01671, at page 2, lines 9-17 and page 13, line 18 to page 15, line 10 of the specification. Applicants submit that new claims 3-48 are not believed to introduce any prohibited new matter.

Applicants elect with traverse the TNF- α inhibitor (a) metalloproteinase inhibitors excluding methylprenisolone.

MPEP § 803 states that an application may be properly restricted to one or more claimed inventions only if (1) the inventions are independent or distinct as claimed, and (2) there is a serious burden on the Examiner if the Restriction is not required. Thus, even if appropriate reasons exist for requiring Restriction, such a Restriction should not be made unless there is an undue burden on the Examiner to examine all of the claims in a single application.

Although the Examiner alleged different classifications for the inventions, it would seem that a search and examination for all the groups of inventions would substantially overlap. For example, a search of TNF- α inhibitors could potentially identify drugs other than metalloproteinase inhibitors which could include other members of the original Markush group if such prior art indeed exists. Because of this apparent overlap in search and examination, a serious burden would not be imposed on the Examiner to examine all

the members of the Markush group (a) to (o) in a single application. Thus, the Restriction is improper and should accordingly be withdrawn.

CONCLUSION

Accordingly, for at least all of the reasons set forth above, withdrawal of the requirement for Restriction is respectfully requested. If there are any questions concerning this paper, or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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